



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012287

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 10/21/2005

Signature

Debra L. Pejeau

Typed or printed name

Debra Pejeau

Application Number

09/976,536

Filed

10/12/2001

First Named Inventor

Jason T. Griffin

Art Unit

2675

Examiner

Amr A. Awad

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

39,142

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

David B. Cochran

Signature

David B. Cochran

Typed or printed name

216-586-7029

Telephone number

10/21/2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit: 2675

Examiner: Amr A. Awad

Inventor: Jason T. Griffin, et al.

Serial No.: 09/976,536

Filed: 10/12/2001

For: Dual Mode Mobile Communication...

Atty. Docket: 555255-012287

**PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1459 on Oct. 21, 2005.

Signature: _____

Debra Pejeau

Typed or Printed Name: _____

Debra Pejeau

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

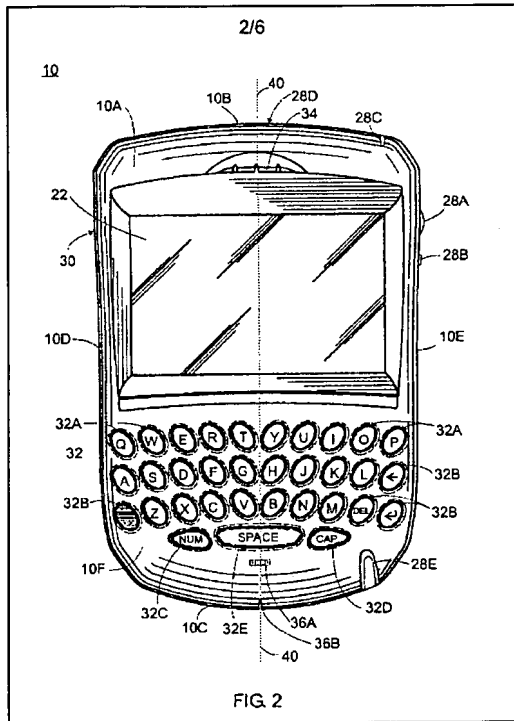
The Examiner finally rejected independent claim 44 as being obvious over Horie (US 6,731,227) in view of Le (US 6,744,890). This claim was also rejected under the doctrine of obviousness type double patenting over US 6,278,422 or US 6,452,588 or US 6,489,950 (all assigned to the assignee of this application) in view of Uchikura (US 5,337,346). These rejections are now appealed. The Applicant hereby requests review of the final rejection prior to filing an appeal brief for the reasons set forth herein.

REASONS FOR PRE-APPEAL BRIEF CONFERENCE REQUEST

Applicant submits that the final rejection of claim 44 is based upon clear errors in fact and fails to establish a *prima facie* case of obviousness. Claim 44 is the sole independent claim remaining in this application. For purposes of this pre-appeal brief conference request only, Applicant limits the argument to this claim.

A. Claim 44 is Patentable Over Horie in view of Le

Claim 44 describes a dual mode mobile communication device capable of sending and receiving voice communications when operating in a voice communication mode and data communications when operating in a data communication mode. The device includes ***a single, integrated device housing*** having a front surface. The single, integrated device housing does not include two or more hinged housing sections, *i.e.*, it is not a “clamshell” design as described in the Background of this application. The device includes two interfaces, a voice communication interface and a data communication interface. The voice interface includes a speaker, a display and a microphone, and is used for operating in the voice mode, *e.g.*, by placing a phone call. The data interface includes the same display as the voice interface and also includes ***a complete alphanumeric keyboard laid out in the QWERTY-style*** for typing text into the device, *e.g.*, e-mail messages. The voice and data interfaces are configured so that the speaker is positioned at the top of the device housing, the display is positioned below the speaker and the complete QWERTY keyboard and the microphone are positioned below the display. The device is operable in either the voice mode or the data mode without reorienting the device.

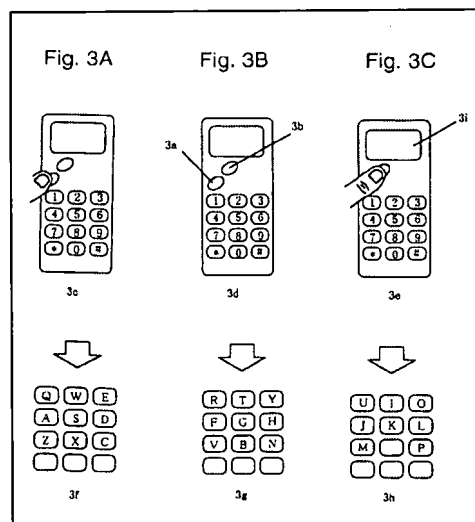


The device 10 shown in Figure 2 of the present application includes *a single, integrated housing 10A* and a *complete alphanumeric keyboard 32* laid out in the QWERTY style. This is not a "clamshell" design, *i.e.*, there are no hinged sections that form part of the housing. This single, integrated housing includes a speaker 34, a display 22, and a microphone 36A. The device 10 can be operated in either voice or data modes *without having to reorient the device housing*. The phrase "without having to reorient the device housing"

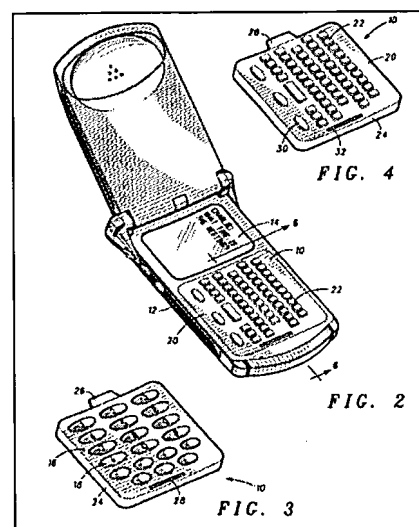
means that the device can be used in either voice or data communication modes without having to rotate the device or without having to open a hinged portion of the device.

The Examiner rejected claim 44 over the combination of Horie and Le. This rejection is faulty, however, because Horie fails to show a "complete alphanumeric keyboard," and because the combination is (i) contrary to the explicit teaching of Horie; and (ii) fails to meet all of the language from claim 44. Example figures from these two patents are set forth below.

Horie (US 6,731,227)



Le (US 6,744,890)



As shown above, Horie does not disclose a complete alphanumeric keyboard laid out in the QWERTY style. Instead, Horie discloses a “virtual” or “imaginary” QWERTY keyboard using three modified versions of a standard 12-key telephone keypad. In Horie, a user must select a function keys (3a, 3b) to switch telephone keypad between three alphabetic key assignments. Thus, in Horie, only a sub-set of the 26 letters of the English alphabet can be selected and thus it is not a complete alphanumeric keyboard.

To overcome this deficiency, the Examiner combines Horie with Le. This combination is faulty, however, because Le is a “clamshell” design that must be substantially reoriented in order to operate in a voice or data mode, and also because Horie itself expressly teaches away from the combination hypothesized by the Examiner. It can be seen in Figs. 2-4 of Le that in order to operate the phone in a data mode, the voice keypad (10 in Fig. 3) must be physically removed from the housing and a completely separate data keypad (10 in Fig. 4) must be substituted. Even if a person would be motivated to combine Le’s removable keyboard with Horie, the combined device would still have to be substantially reoriented in order to use it in the data mode because Le’s keyboard could only fit into the Horie device in the same manner that it is positioned in the Le device.

Finally, with respect to the motivation to combine, the fact remains that the Horie reference itself *teaches away* from the combination, even stating that a QWERTY keyboard cannot be employed, and therefore there cannot possibly be any motivation to combine Horie with Le:

“However, since small-sized character input device for use with a mobile telephone or the like encounters difficulties in accommodating keys for 26 alphabet letters, *the qwerty arrangement cannot be employed.*” (Horie, Col. 1, ll. 34-37)

Therefore, for all of these reasons, it is submitted that claim 44 is patentably distinct from Horie in view of Le.

B. Double Patenting Rejection

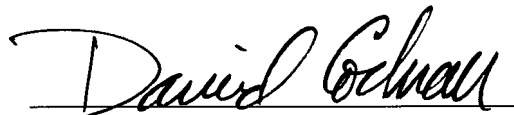
The Examiner's conclusion that the claims of the present application are substantially similar to the claims of the assignee's prior patents US 6,278,442, US 6,452,588 and US 6,489,950 is wrong, and thus the double patenting rejection cannot be supported.

The claims of these prior patents are not restricted to a dual mode device as set forth in claim 44. Moreover, these prior claims do not recite "a single integrated device housing that does not include two or more hinged housing sections," nor do they recite "a voice communication interface," nor do they recite the positioning of the speaker and the microphone as set forth in claim 44, nor do they recite that the dual mode device is "operable in either the voice mode of operation or the data mode of operation without reorienting the device." Because all of these limitations are missing from the claims of these prior patents, the double patenting rejection should be withdrawn.

The Applicant respectfully requests withdrawal of the rejections in light of the aforementioned arguments. It is believed that the application, as now presented, is in condition for allowance and that a Notice of Allowability be issued.

Respectfully submitted,

JONES DAY

A handwritten signature in black ink, appearing to read "David B. Cochran", written over a horizontal line.

David B. Cochran

(Reg. No. 39,142)

Jones Day

North Point, 901 Lakeside Avenue

Cleveland, Ohio 44114

(216) 586-7029